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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,846	04/15/2004	John M. Nieminen	07508-055001	6867
26161	7590	05/05/2006	EXAMINER	
FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			BHAT, ADITYA S	
			ART UNIT	PAPER NUMBER
			2863	

DATE MAILED: 05/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/824,846	Applicant(s) NIEMINEN ET AL.	
	Examiner Aditya S. Bhat	Art Unit 2863	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-37 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-17, drawn to, adjusting a position indication based on the disturbed amplitude and phase classified in class 702, subclass 94.
- II. Claims 18-22, drawn to a characteristic mathematical formulation describing an undistorted frequency function, classified in class 330, subclass 149.
- III. Claims 23-37, drawn to a characteristic frequency function of an undisturbed magnetic tracking system, classified in class 324, subclass 207.23.

The inventions are distinct, each from the other because of the following reasons:

Inventions of each of groups I-III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, inventions can each be used for their respective uses as explained below

Inventions of groups I and II are related as combination and sub-combination. Inventions in this relationship are distinct if it can be shown that

(1) the combination as claimed does not require the particulars of the sub-combination as claimed for patentability, and

(2) that the sub-combination has utility by itself or in other combinations. (M.P.E.P. § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the sub-combination as claimed, specifically a position indication based on

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the disturbed amplitude and phase. The subcombination has separate use as a characteristic mathematical formulation describing an undistorted frequency function.

Inventions of groups I and III are related as combination and sub-combination. Inventions in this relationship are distinct if it can be shown that

(1) the combination as claimed does not require the particulars of the sub-combination as claimed for patentability, and

(2) that the sub-combination has utility by itself or in other combinations. (M.P.E.P. § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the sub-combination as claimed, specifically an position indication based on the disturbed amplitude and phase. The subcombination has separate use as a undisturbed magnetic tracking system.

Inventions of groups II and III are related as combination and sub-combination. Inventions in this relationship are distinct if it can be shown that

(1) the combination as claimed does not require the particulars of the sub-combination as claimed for patentability, and

(2) that the sub-combination has utility by itself or in other combinations. (M.P.E.P. § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the sub-combination as claimed, specifically a characteristic mathematical formulation describing an undistorted frequency function. The subcombination has separate use as a undisturbed magnetic tracking system.

Because these inventions are distinct for the reasons given above and the search required for Group I which is adjusting a position indication based on the disturbed amplitude and phase is not required for Group II a characteristic mathematical formulation describing an undistorted frequency function, Group II a characteristic

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mathematical formulation describing an undistorted frequency function is not required for Group III a characteristic frequency function of an undisturbed magnetic tracking system, Group I which is adjusting a position indication based on the disturbed amplitude and phase is not required for Group III a characteristic frequency function of an undisturbed magnetic tracking system, restriction for examination purposes as indicated is proper.

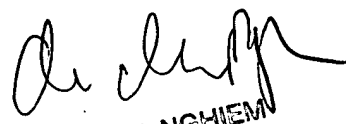
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aditya S. Bhat whose telephone number is 571-272-2270. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Barlow can be reached on 571-272-2269. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Aditya Bhat
April 15, 2006


MICHAEL NGHIEM
PRIMARY EXAMINER